

REMARKS

Reconsideration and allowance are respectfully requested. Claims 1-34 remain pending.

Claims 1, 2, 5, 9-15, 18-20, 22, 26-31 and 34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Burg in view of Schneider et al. This rejection is respectfully traversed.

Burg discloses a system for processing a telephone call to an on-line subscriber when the subscriber's telephone line is busy due to being on-line. The incoming call is forwarded to a server and information about the call is stored in a call-back list server. The system sends a message to the subscriber and the subscriber can review the call-back list and return calls or listen to messages while remaining on-line.

In Burg, when, in a response to a subscriber's incoming call to connect to the Internet, a record of subscriber information is made and if the subscriber enters the correct name and password, the subscriber is permitted to access the Internet. Once on the Internet, the subscriber can access his or her voice mail (messages).

Applicants submit that in interpreting the claims, the Examiner is not appreciating the difference between a calling party (caller or subscriber) and the called party. This is evident by the fact that the Examiner at page 3 of his Office Action recites "called party (caller)". A calling party is the person making a call, and a called party is the person to whom the calling party is calling. In interpreting the claims, a called party cannot be both the one who is called and the calling party (caller). It appears that the Examiner is considering the subscriber in Burg to be the calling party (as defined in the claims) who calls into his service for Internet access. If this is the case, the Examiner must be considering the "called party" as the one leaving a voice message for the calling party.

The Examiner states "Burg does not specifically disclose the messaging prompt to the user." Applicants assume that the Examiner is using the term "user" to mean the

subscriber or calling party who is accessing the Internet for his messages in Burg. The Examiner then cites Schneier as disclosing a message prompt to a user and contends it would be obvious to implement the Schneier feature in Burg to connect user to the Internet.

There is no suggestion in Burg or Schneier of retrieving a personalized voice message of a first party corresponding to a matched, stored number information of second party, for playback to the second party as a messaging prompt. Teachings of references can be combined only if there is some suggestion or incentive to do so. In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original).

Even if the teachings of Schneier were combined with Burg, the combination would not result in the claims. In particular, Schneier merely teaches that a user is prompted to speak his or her name to create a voiceprint. This is not a teaching or suggestion of retrieving a personalized voice message of a called party corresponding to a matched, stored calling party number information, for playback to the calling party as the messaging prompt. There is no disclosure in Schneier that the prompt is a voice message, let alone a personalized voice message as claimed. In addition, if the prompt of Schneier were employed in Burg, the prompt would merely be a request for the subscriber to speak so as identify the subscriber. Such identification would be unnecessary since, in Burg, the subscriber has previously been identified by his password. Thus, the rejection is improper and should be withdrawn.

Claims 3, 6-8, 16, 17, 21, 23-25, 32 and 33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Burg in view of Schneier and further in view of Bobo. These claims depend from the independent claims and are considered to be allowable for the reasons advanced above and for the additional reason that the added subject matter thereof is neither taught nor suggested by the prior art of record.

Gress et al. –Application No. 09/633,899
Response filed: February 19, 2004

In view of the foregoing, it is believed this application is in condition for allowance, and such as Notice is respectfully solicited.

To the extent necessary, Applicant petitions for an extension of time under 37 C.F.R. 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including any missing or insufficient fees under 37 C.F.R. 1.17(a), to Deposit Account No. 50-1130, under Order No. 95-445, and please credit any excess fees to such deposit account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'E. Stemberger', with a stylized, flowing script.

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